



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re application of:

ZAUDERER *et al.*

Appl. No.: 10/809,790

Filed: March 26, 2004

For: **Targeted MHC Class I Alpha3
Vaccine Delivery Systems**

Confirmation No.: 7155

Art Unit: 1646

Examiner: SZPERKA, Michael E.

Atty. Docket: 1843.0120001/EKS/AJK

Reply to Restriction Requirement and Election of Species

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the Office Action dated January 12, 2005, requesting an election of one invention to prosecute in the above-referenced patent application, Applicants hereby provisionally elect to prosecute the invention of Group I, represented by claims 1-19. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

This election is made with traverse.

With respect to the Examiner's division of the claims into five groups and the reasons stated therefor, Applicants respectfully traverse. Each of the groups is related. For example, Groups I, II and III are related as between compounds which each comprise an MHC Class I $\alpha 3$ domain and a $\beta 2$ -microglobulin. Groups I, II and III and IV are related as between compounds and a polynucleotide which encodes at least a part of the compound. Groups I, II and III and V are related as between compounds and methods of using the compounds.

Furthermore, all of the claims can be examined without serious burden on the Examiner because a search of the art for the claims of Group I should find art relevant to the claims of any other groups. For example, Groups I, II and III are grouped in the same class for search purposes. Therefore, fewer restriction groups should expedite prosecution without an undue burden on the Examiner.

Even assuming, *arguendo*, that Groups I-V represent distinct or independent inventions, Applicants submit that to search and examine the subject matter of these Groups together would not be a serious burden on the Examiner. In particular, any art related to a compound of Group I, is very likely to overlap substantially with art related to a compound of Groups II or III, the polynucleotide of Group IV, or the method of Group V. Accordingly, it would not be an undue burden for the Examiner to search the Groups together. The M.P.E.P. § 803 (8th ed., Aug. 2001, Rev. May 2004) states:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Thus, in view of the M.P.E.P. § 803, Applicants respectfully request that all claims be searched and examined in the subject application. Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

Additionally, Applicants specifically request rejoinder of the claims of Group V should any of the claims of Group I-III be found allowable.

Reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested.

The Examiner has also required species elections. Applicants' provisional elections are listed below, along with a listing of each of the claims believed to read on each of the provisionally-elected species.

These elections are made **with** traverse.

1. The Examiner has required an election of species among cell surface marker sources. Applicants hereby provisionally elect to prosecute the species comprising tumor cells. Claims 1-5, 9 and 14-19 read on the provisionally elected species.

2. The Examiner has required an election of species among peptide sources. Applicants hereby provisionally elect to prosecute the species comprising infectious agent/infected cell. Claims 1-14, 16 and 19 read on the provisionally elected species.

Applicants respectfully traverse and request the withdrawal of the requirement for election of species. On page 5 of the Office Action, the Examiner asserts that the claims are directed to patentably distinct species. However, as a threshold matter, Applicants point out that MPEP § 803 lists the criteria for a proper restriction requirement:

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 – § 806.04(i)) or distinct (MPEP § 806.05 – §806.05(i)).

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Thus, even assuming, *arguendo*, that the subgroups listed by the Examiner represent patentably distinct species, restriction remains improper unless it can be shown that the search and examination of the listed groups would entail a "serious burden." *See* M.P.E.P. § 803. In the present situation, no such showing has been made. For example, although the Examiner has asserted that embodiments referring to cell surface marker source are distinct species, Applicants submit that a search of tumor cell antibodies would provide useful information regarding other types of antibodies, such as antibodies to T cells. Thus, the search and examination of all species would not entail a serious burden.

Applicants assert the right to have additional species examined in the event that a generic claim is found to be allowable in accordance with 37 C.F.R. § 1.141(a). Currently, at least claims 1-19 are generic to the elected species.

Reconsideration and withdrawal of the Requirement for Election of Species, and consideration and allowance of all pending claims, are respectfully requested.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefore are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

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